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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 10/709,617 | 05/18/2004 | Keith Andrew Talbot | 717228.9 | 3616 |
| 27128 | 7590 | 09/16/2005 | | |
| BLACKWELL SANDERS PEPER MARTIN LLP 720 OLIVE STREET SUITE 2400 ST. LOUIS, MO 63101 | | | EXAMINER TAWFIK, SAMEH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3721 | |

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/709,617 | TALBOT ET AL. | |
| | Examiner | Art Unit | |
| | Sameh H. Tawfik | 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05182004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-17 and 25-27) in the reply filed on 07/26/2005 is acknowledged. The traversal is on the ground(s) that the submitted apparatus of claim 1 can not practice a process materially different from that disclosed in claim 18 as both claims disclose the same elements. This is not found persuasive because as disclosed on paper Num. 06242005 that the process as claimed can be practiced by another materially different apparatus such as one without a spacer mechanism to space the carriers in a sequence at a predetermined locations; as the process claim does not disclose space between the carriers while the apparatus claim discloses a spacer mechanism to space the carriers in sequence.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 18-24 drawn to an invention nonelected with traverse in Paper No. 07262005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "the cover slip" in line 17. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11-14, 16, 17, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego (5,664,405) in view of Gelardi et al. (6,527,500).

Perego discloses an apparatus for assembling a plurality of storage media carriers into a single assembly including a first magazine adapted to retain a plurality of carriers in a stack (Fig. 1; via carriers stack 3); a conveyor system having at least a first conveyor adapted to receive carriers from the magazine as released by the depositor and to convey a plurality of carriers therealong in a row having a longitudinal axis (Fig. 1; via conveyor to convey the carriers); a source adapted to contain a plurality of cover strips (Fig. 1; via cover 8); an applicator adapted to apply a cover strip from the source to a plurality of the carriers (Fig. 4; via cover 8 into carrier 3); the cover strip (8) to be applied has a longitudinal axis generally parallel to the longitudinal axis of the row of carriers and generally parallel to the direction of movement of the first conveyor (Fig. 1). Perego does not disclose a carrier depositor to release the lower most positioned carriers from the magazine. However, the examiner takes an official notice that such depositor from lower most positioned of any stack is old, well known, and available in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perego apparatus by having means to dispense the carriers 3 from the bottom, as a matter of engineering design choice, in order to avoid any damage to the carriers while dispensing them from the top and to speed up the process.

Perego neither disclose a glue depositor operable to deposit glue on the carriers nor a spacer mechanism adapted to space the carriers in a sequence. However, Gelardi discloses a similar apparatus comprising a glue depositor operable to deposit glue on the carriers (column 3, lines 3-5) and a spacer mechanism adapted to space the carriers in a sequence (Fig. 8A; via carrier spindles 89).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perego's apparatus by having a glue depositor operable to deposit glue on the carriers and a spacer mechanism adapted to space the carriers in a sequence, as suggested by Gelardi, in order to control the movement and space between the carriers while conveying them and strongly bonding the covers 8 into carriers 3.

Regarding claims 2 and 27: Perego discloses that the conveyor system is operable to move the carriers in a generally straight line from the magazine and through the glue depositor and applicator (Fig. 1).

Regarding claims 3, 4, and 12: Perego does not disclose a spacer mechanism with plurality of ears mounted to the conveyor. However, Gelardi discloses similar apparatus comprising a spacer mechanism with ears adapted to space the carriers in a sequence to push the carriers in the direction of movement (Fig. 8A; via carrier spindles 89).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perego's apparatus by having a spacer mechanism with ears adapted to space the carriers in a sequence, as suggested by Gelardi, in order to control the movement and space between the carriers while conveying them.

Regarding claim 5: Perego discloses the carrier depositor includes a first mechanism to assist gravity induced downward movement of a lower-most positioned carrier in the magazine (Fig. 1; via guide rails on the magazine).

Regarding claim 11: Perego discloses the conveyor system includes a second conveyor positioned to receive released carriers thereon and operable to transfer released carriers to the first conveyor (Fig. 1; via different conveyors).

Regarding claims 13 and 14: Perego does not disclose the second conveyor includes two conveyor tracks with at least a portion of each conveyor track positioned outside of a respective side edge of the first conveyor nor a control device to control the time of release of carriers. However, the examiner takes an official notice that such conveyor track positioned at side edges of main conveyor and the use of control device on such apparatus is old, well known, and available in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perego in view of Gelardi by using conveyor track positioned at side edges of the main conveyor, in order to guide and avoid falling of the conveying carriers or product; and by using control device, in order to control the different stations and the feeding process of the carriers, as a matter of engineering design choice.

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Regarding claims 16 and 17: Perego nor Gelardi disclose mechanism to prevent glue from trailing at the glue depositor nor source of hot air directed at a glue outlet. However, the examiner takes an official notice that such mechanism to prevent glue from trailing at the glue depositor and source of hot air directed at a glue outlet are old, well known, and available in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perego in view of Gelardi's apparatus by having mechanism to prevent glue from trailing at the glue depositor and source of hot air directed at a glue outlet, as a matter of engineering design choice, in order to avoid leaking of the glue into the carrier if not needed and to dry the glue faster.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is 571-272-4470. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sameh H. Tawfik
Patent Examiner
Art Unit 3721



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